IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Cory O. Nykoluk et al.	:	
	:	Group Art Unit: 3781
Serial Number: 10/688,477	:	
	:	Examiner: Tri M. Mai
Filed: October 17, 2003	:	
	:	
For: PIVOTAL HANDLE FOR TOWABLE BAGGAGE	:	

APPELLANT'S APPEAL BRIEF

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In response to the Final Office Action dated February 27, 2008 and the Advisory Action dated April 24, 2008, Appellants hereby concurrently submit a Notice of Appeal and the present Appeal Brief.

This brief is transmitted in triplicate and the fee required under 37 C.F.R. § 1.17(f) is submitted herewith as set forth in the accompanying transmittal letter. This brief contains the following sections under the headings and in the order set forth below.

I.	Real Party in Interest
II.	Related Appeals and Interferences
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Appendix A. Claims Involved in the Appeal

Pursuant to the provisions of 37 C.F.R. §41.37, Appellants submit the following brief.

I. Real Party in Interest

The real party in interest is Centric Group, LLC of St. Louis, Missouri. Centric Group LLC is the sole owner and parent entity of TRG Accessories, LLC, the assignee of record.

II. Related Appeals and Interferences

In the interest of disclosure, Appellants note that a number of co-pending and commonly owned patent applications have been finally rejected by the same examiner as the application of the present appeal, and are the subject of concurrent appeal proceedings.

More specifically, Appeal briefs have been filed in U.S. Application Serial Nos. 10/072,042 and 10/238,390 that are each commonly owned and in the same patent family as the application that is the subject of the present appeal. As a matter of substance, the appeals of Application Serial Nos. 10/072,042 and 10/238,390 involve different issues from the present appeal and it is not believed that decisions in those appeals will likely directly affect, be affected by, or have a bearing on the Board's decision in the present appeal.

The relation of Application Serial Nos. 10/072,042 and 10/238,390 to the application that is the subject of the present appeal is as follows. The application that is the subject of the present appeal is a continuation of U.S. Patent No. 6,651,791. Application Serial No. 09/990,076, now abandoned, was filed as a continuation-in-part application of the application that became U.S. Patent No. 6,651,791. Application Serial No. 10/072,042 was filed as a continuation-in part application of U.S. Application Serial No. 09/990,076. Application Serial No. 10/238,390 is a continuation-in-part of U.S. Application Serial No. 10/072,042.

It is further noted that an appeal of U.S. Application Serial No.10/875,394 has been fully briefed and is presently pending before the Board for decision. Application Serial No.10/875,394 is another commonly owned application with the present application but belongs to a different patent family. As a matter of substance, the appeal of Application Serial No. 10/875,394 involves different issues from the present appeal and it is not believed that a decision in that appeal will likely directly affect, be affected by, or have a bearing on the Board's decision

in the present appeal.

III. Status of Claims

Claims 30-35, 38-50 and 53-56 remain in the application. Claim 31 stands objected to, and claims 53-56 have been allowed. Claims 30, 32-35, and 38-50 are finally rejected and are appealed.

IV. Status of Amendments

All amendments have been entered.

V. Summary of Claimed Subject Matter

The following summary does not limit, in any manner whatsoever, the claim interpretation. Rather, the following summary is provided only to facilitate the Board's understanding of the subject matter of this appeal. Specifically, the present invention is defined by the following independent claims 30, 48 and 53 as set forth below in Tables 1-3, respectively, in which the claim language is correlated to exemplary portions of the specification that support the claim language and with citations to the pertinent drawings that illustrate recited features. Reference numerals corresponding to the specification are also provided. Specific citations to the specification and drawings are exemplary only and are not intended to be the sole sources of support for the invention claimed. That is, other portions of the specification and other drawings may also support the invention claimed.

Table 1

Independent Claim 30

Claim Language	Specification and Drawing Support
30. A hand towed piece of baggage comprising:	The invention pertains to the field of hand towable travel baggage. *See* page 1, lines 4-5.
a piece of baggage having a top and a bottom;	Backpack 22 or other type of baggage. *See* page 8, lines 15-21 and Figure 1. The backpack includes a top and a bottom.
a set of wheels rotationally mounted towards said bottom of said piece of baggage;	Wheeled backpack 22. *See* page 8, lines 15-16 and Figure 1. The set of wheels is rotationally mounted at the bottom of the backpack 22.
a receptacle providing an opening in said top of said piece of baggage;	Receptacle 80 provided in the top of the backpack 22. *See* page 12, lines 6-7 and Figure 2.
an arm portion retractably engaged to said piece of baggage and having an adjustable axial length extending between opposite proximal and distal ends, said proximal end being operatively secured to said piece of baggage and said distal end positionable between an extended position and a retracted position through said receptacle, wherein in said retracted position said distal end is closer to said piece of baggage than in said extended position;	Arm portion 24 is a retractable telescoping member defining a center axis A-A along its length. The arm 24 includes tubular sections 30, 32, 34. The tubular section 34 is fixed inside the backpack 22 at a proximal end and the tubular section 30 has a free distal end 38. *See* page 8, line 22 to page 9, line 14. The length of the arm portion 24 is adjustable to position the free end 38 between the extended and retracted positions. The arm portion 24 is shown in an extended position in Figure 1 and a retraced position shown in Figure 2. The free distal end 38 is closer to the backpack 22 in the retracted position than in the extended position. *See* page 11, line 32 to page 12, line 7.
a connector fixedly mounted to said distal end; and	Connector 54 secured to the free end 38 with a pair of screws or rivets. *See* page 10, lines 8-26 and page 11, lines 18-25 and Figures 1, 4 and 6.

a towing handle having a hand grip, the towing handle being separately provided from the connector and engaged to the connector such that said hand grip can pivot relative to said connector about a pivot axis that intersects the hand grip when said arm portion is in said extended position, and such that said towing handle grip is retracted at least partially into said receptacle when said arm portion is in said retracted position.	Towing handle 26 having a hand grip 42. *See* page 9, lines 15-23 and Figures 3-6. In addition to the towing handle 26, a connector 54 is provided. *See* page 10, lines 6-9. The towing handle 26 is attached to the connector 54 to provide flush, rotational sliding engagement therebetween. *See* page 11, lines 10-15 and Figures 4 and 6. The towing handle 26 is free to pivot about the center axis A-A of the arm portion 24. *See* page 11, lines 26-28 and Figures 4 and 6. The center axis A-A intersects the hand grip 42 of the towing handle 26. *See* Figure 1. In the retracted position, the towing handle 26 and grip 42 is retracted into the receptacle 80 of the backpack 22. *See* page 12, lines 15-18 and Figure 2.

Table 2

Independent Claim 48

Claim Language	Specification and Drawing Support
48. A hand towed piece of baggage comprising:	The invention pertains to the field of hand towable travel baggage. *See* page 1, lines 4-5.
a piece of baggage;	Backpack 22 or other type of baggage. *See* page 8, lines 15-21 and Figure 1. The backpack includes a top and a bottom.
a set of wheels rotationally mounted on the piece of baggage;	Wheeled backpack 22. *See* page 8, lines 15-16 and Figure 1. The set of wheels is rotationally mounted on the backpack 22.
a retractable arm portion, the arm portion comprising a plurality of tubular sections that are telescopically engaged with each other and having an axial length extending between opposite proximal and distal ends, the proximal end being operatively secured to the piece of baggage and the distal end being selectively movable between a retracted position and an extended position relative to the proximal end via the tubular sections telescoping in a manner such that the distal end is closer to the piece of baggage when in the retracted position than when the distal end is in the extended position, the arm portion further having a non-circular cross section perpendicular to the axial length so that the tubular sections cannot slidably twist relative to each other when the distal end of the arm portion is in the extended position;	Arm portion 24 is a retractable telescoping member defining a center axis A-A along its length. The arm 24 includes tubular sections 30, 32, 34. The tubular section 34 is fixed inside the backpack 22 at a proximal end and the tubular section 30 has a free distal end 38. *See* page 8, line 22 to page 9, line 14. The length of the arm portion 24 is adjustable to selectively position the free end 38 between the extended and retracted positions relative to the proximal end. The arm portion 24 is shown in an extended position in Figure 1 and a retraced position shown in Figure 2. The free distal end 38 is closer to the backpack 22 in the retracted position than in the extended position. *See* page 11, line 32 to page 12, line 7. The tubular sections 30, 32, 34 have an elliptical or oval cross section that would prevent the sections from slidably twisting relative to one another. *See* page 8, lines 25-27 and Figure 1.
a connector mounted stationary to the distal end;	Connector 54 secured to the free end 38 with a pair of screws or rivets. *See* page 10,

	lines 8-26 and page 11, lines 18-25 and Figures 1, 4 and 6.
a towing handle having a hand grip, the towing handle being separately provided from the connector and abutting the connector in a manner such that the hand grip can pivot relative to the connector about a pivot axis that intersects the hand grip when the distal end of the arm portion is in the extended position;	Towing handle 26 having a hand grip 42. *See* page 9, lines 15-23 and Figures 3-6. In addition to the towing handle 26, a connector 54 is provided. *See* page 10, lines 6-9. The towing handle 26 is attached to the connector 54 to provide flush, rotational sliding engagement therebetween. *See* page 11, lines 10-15 and Figures 4 and 6. The towing handle 26 is free to pivot about the center axis A-A of the arm portion 24 in the extended position. *See* page 11, lines 26-28 and Figures 1, 4 and 6. The center axis A-A intersects the hand grip 42 of the towing handle 26. *See* Figure 1.
wherein the towing handle is generally unobtrusive when in the retracted position.	In the retracted position, the towing handle 26 and grip 42 is retracted into the receptacle 80 of the backpack 22 where it lies flush and is unlikely to become snagged on other items. *See* page 12, lines 15-18 and Figure 2. The towing handle is retracted such that is unobtrusive and does not otherwise interfere with the use of the piece of baggage. *See* page 5, lines 24-28.

Table 3

Independent Claim 53

Claim Language	Specification and Drawing Support
53. A hand towed piece of baggage comprising:	The invention pertains to the field of hand towable travel baggage. *See* page 1, lines 4-5.
a piece of baggage;	Backpack 22 or other type of baggage. *See* page 8, lines 15-21 and Figure 1. The backpack includes a top and a bottom.
a set of wheels rotationally mounted on the piece of baggage;	Wheeled backpack 22. *See* page 8, lines 15-16 and Figure 1. The set of wheels is rotationally mounted on the backpack 22.
a retractable arm portion, the arm portion comprising a plurality of curved tubular sections that are telescopically engaged with each other and having an arched axial length extending between opposite proximal and distal ends, the proximal end being operatively secured to the piece of baggage and the distal end being selectively movable between a retracted position and an extended position relative to the proximal end via the tubular sections telescoping in a manner such that the distal end is closer to the piece of baggage when in the retracted position than when the distal end is in the extended position;	Arm portion 24 is a curved retractable telescoping member defining a center axis A-A along its length that follows an arcuate path. The arm 24 includes tubular sections 30, 32, 34. The tubular section 34 is fixed inside the backpack 22 at a proximal end and the tubular section 30 has a free distal end 38. *See* page 8, line 22 to page 9, line 14. The length of the arm portion 24 is adjustable to move the free end 38 between the extended and retracted positions. The arm portion 24 is shown in an extended position in Figure 1 and a retraced position shown in Figure 2. The free distal end 38 is closer to the backpack 22 in the retracted position than in the extended position. *See* page 11, line 32 to page 12, line 7.
a connector mounted stationary to the distal end;	Connector 54 secured to the free end 38 with a pair of screws or rivets. *See* page 10, lines 8-26 and page 11, lines 18-25 and Figures 1, 4 and 6.
a towing handle having a hand grip, the towing handle being separately provided from the connector and abutting the connector in a	Towing handle 26 having a hand grip 42. *See* page 9, lines 15-23 and Figures 3-6.

manner such that the hand grip can pivot relative to the connector about a pivot axis that intersects the hand grip when the distal end of the arm portion is in the extended position.	In addition to the towing handle 26, a connector 54 is provided. *See* page 10, lines 6-9. The towing handle 26 is attached to the connector 54 to provide flush, rotational sliding engagement therebetween. *See* page 11, lines 10-15 and Figures 4 and 6. The towing handle 26 is free to pivot about the center axis A-A of the arm portion 24 in the extended position. *See* page 11, lines 26-28 and Figures 1, 4 and 6. The center axis A-A intersects the hand grip 42 of the towing handle 26. *See* Figure 1.

VI. Grounds of Rejection to be Reviewed on Appeal

A. Whether claims 30, 34, 35 and 38-47 are unpatentable under 35 U.S.C. § 103(a) over Sadow in view of Liang and further in view of Sparks.

B. Whether claims 32 and 33 are unpatentable under 35 U.S.C. § 103(a) over Sadow in view of Liang and Sparks and further in view of Browning.

C. Whether claims 48, 49 and 50 are unpatentable under 35 U.S.C. § 103(a) over Sadow in view of Liang and Sparks, and further in view of Miyoshi.

D. Whether claims 30, 34, 35, 37 and 42-47 are unpatentable under 35 U.S.C. § 102(b) as anticipated by Williams et al.

VII. Argument

Appellants respectfully submit that each rejected claim in the present application is patentable over the art cited by the Examiner in rejecting such claims. Accordingly, Appellants respectfully traverse the rejections of the pending claims, and request that the Final Rejection be reversed and that the pending claims be allowed. In support of these requests, a background

discussion of the cited art and a detailed discussion regarding the patentability of the claims vis-à-vis the cited art is set forth below.

A. Background Discussion of the Cited Art

Six references are cited against the present claims. The references are briefly discussed below, and are discussed in detail hereinbelow with respect to the specific rejections wherein they have been cited.

U.S. Patent No. 5,890,570 to Sadow discloses a wheeled carry-on travel case having a guide tube (18) and a retractable handle (20) received within the guide tube (18). As described by Sadow, the handle (20) can be rotated within the guide tube (18) between two positions rotated 90° from one another. See Col. 3, lines 19-25. That is the Sadow handle (20), including the cross bar at the top the handle where a user would grip the handle, rotates relative to the guide tube (18). Sadow does not disclose that the cross bar handle grip rotates relative to any portion of the handle (20) or the arm portion.

U.S. Patent No. 5,464,080 to Liang discloses an article of luggage including, as shown in the figures, front casters (24) that are described as freely and omnidirectionally pivotal, and orientationally fixed rear wheels (24) that follow the direction of travel of the suitcase as it is pulled by a user. Liang discloses a steering apparatus for the suitcase including a ball (32) and socket (30) joint, a pivotal hinge (38), telescoping rods (54) and (56), and a handle (42) that in combination allow easy and convenient steering of the suitcase in any direction. Also, Liang notes that the position of the socket (30) is below the center of gravity of the case (10) for enhanced stability of the case while being steered and reducing a likelihood that the case will tip or fall over.

U.S. Patent No. 853,566 to Sparks discloses a ferrule attachment for uniting a handle and shank of a shovel. To that end, Sparks describes a simple practical and efficient means for "rigidly uniting" the ferrule to the handle. *See* Sparks page 1, lines 16-19. Sparks describes a ferrule (2) provided with a groove (7) that receives a bar (3). The bar (3) is joined to the ferrule (2) with a rivet (8) to "lock the bar and ferrule to each other against relative movement." *See* Sparks page 1, lines 62-67. Sparks further describe that the shank is snugly fitted within the ferrule to "prevent relative movement of the parts one upon the other." *See* Sparks page 1, lines

70-77. Sparks does not disclose a handle that pivots relative to a connector at the distal end of the arm or that pivots relative to any portion of the arm.

U.S. Patent No. 3,606,372 to Browning discloses wheeled luggage having a retractable handle (13) including a rod member (14) and hand grip (15). Browning does not disclose that the handle grip pivots relative to a connector at the distal end of the arm or that pivots relative to any portion of the arm.

U.S. Patent No. 5,908,093 to Miyoshi discloses a bag including a fixed handle (i.e., a handle that cannot turn or otherwise be adjustable in position in relation to a supporting structure).

U.S. Patent No. 4,358,709 to Williams et al. discloses baggage that may serve as a cart for other pieces of baggage. The Appellants and the Office disagree whether Williams discloses a connector per the instant claims and whether the handle (20) disclosed by Williams et al. can pivot in a manner that would satisfy the rejected claims. Appellants submit that the text of Williams is completely silent regarding material points of the invention as claimed, while the Office relies on a cross sectional drawing found in the Williams et al. Figures to conclude that the recited features are present.

B. Detailed Discussion of the Rejections and Arguments for Patentability

After a brief discussion of the applicable law of claim construction and the applicable law of obviousness, the issues for review will be considered in detail below in the order raised in the Final Office Action dated November 27, 2007.

1. The Applicable Law of Claim Construction

Proper construction of the claims is the starting point for examination of claims for patentability over the prior art. It is well established that in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification. In re Sneed, 218 USPQ 385 (Fed. Cir. 1983). The PTO is to apply to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever

enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification. In re Morris, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).

The rejections in Final Office Action do not give certain recitations of the claims patentable weight, and appears to reflect a preference of specific structure to be recited in the claims. MPEP § 2173.02 cautions the Office that an examiner should not reject claims or insist on their own preferences if the statutory requirements are otherwise met. MPEP § 2173.05(g) also states that functional language must be evaluated and considered, just like any other limitation of the claim – for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. As such, assertions in the final rejections that the claims must be distinguished in terms of structure rather than function is not in accord with controlling law or policies of the Office for purposes of examination.

2. The Applicable Law of Obviousness

Section 103, in pertinent part, provides:

> A patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. 35 U.S.C. § 103.

The United States Supreme Court, in KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1734 (2007), recently pronounced that the question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. Id. (citing Graham v. John Deere Co., 383 U.S. 1, 17-18, (1966)). See also KSR, 127 S.Ct. at 1734 ("While the sequence of these questions might be reordered in any particular case, the [Graham] factors continue to define the inquiry that controls.")

In KSR, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," id. at 1739, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that "the principles laid down in Graham reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." Id. The Court noted that "[t]o facilitate review, this analysis should be made explicit." Id. at 1740-41, citing In re Kahn, 441

F.3d 977, 988 (Fed. Cir. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness"). However, "the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." Id.

The Federal Circuit Court of Appeals, applying KSR, recently recognized that "[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." Leapfrog Ent., Inc. v. Fisher-Price, Inc., 485 F.3d 1157, 1161 (Fed. Cir. 2007) (citing KSR, 127 S.Ct. 1727, 1739, 82 USPQ2d 1385, 1395 (2007).

Further, as the Federal Circuit has explained, under Section 103 "it is impermissible . . . to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." In re Wesslau, 147 USPQ 391, 393 (CCPA 1965). Also, if art "teaches away" from a claimed invention, such a teaching supports the nonobviousness of the invention. U.S. v. Adams, 148 USPQ 479 (1966). See also, Helena Laboratories, Corp., 8 USPQ2d 1468, 1475 (Fed. Cir. 1988) ("claims, entire prior art, and prior art patents must be read as a whole"). If art 'teaches away" from a claimed invention, such a teaching supports the nonobviousness of the invention. U.S. v. Adams, 148 USPQ 479 (1966); Gillette Co. v. S.C. Johnson & Son Inc., 16 USPQ2d 1923, 1927 (Fed. Cir. 1990).

As the Federal Circuit has further explained:

> The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that [the invention] should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. See Burlington Industries v. Quigg, 822 F.2d 1581, 1583, 3 USPO2d 1436, 1438 (Fed. Cir. 1987); In re Hedges, 783 F.2d 1038, 1041, 228 USPQ 685, 687 (Fed. Cir. 1987); Orthopedic Equipment v. United States 702 F.2d 1005, 1013, 217 USPQ 193 200 (Fed. Cir. 1983); In re Rhinheart, 531 F.2d 1048, 1053-54, 189 USPQ 143, 148 (CCPA 1976). *Both the suggestion and the*

> *expectation of success must be founded in the prior art, not in the applicant's disclosure. In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must he considered; for the person of ordinary skill is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention Evidence that supports, rather than negates, patentability must be considered.*

In re Dow Chemical Co., (5USPQ2d 1529 at 153111532 (Fed. Cir. 1988) (emphasis added). In a similar vein, the U.S. Supreme Court in KSR also made it clear that obviousness is not proved merely by demonstrating that claimed elements were, independently, known in the prior art. In KSR, the Supreme Court cautioned that obviousness conclusions should not rely on ex post reasoning. Temptations to read the teaching of an invention into the prior art, and to view the prior art with hindsight in light of the teaching of an invention, should be resisted. That is, the teachings of a patent disclosure should not affect the hypothetical analysis of what a person of ordinary skill, without having the benefit of the patent disclosure, would have done at the time of the invention.

(3) The pending claims are patentable over the cited art.

Appellant's submit that the pending claims are patentable over the cited art, and will consider each of these issues in turn below.

(a.) Sadow in view of Liang and further in view of Sparks.

Appellants request reversal of the rejection of claims 30, 34, 35 and 38-47 under 35 U.S.C. § 103(a) as being unpatentable over Sadow in view of Liang and further in view of Sparks. It is not believed that the cited references present a *prima facie* case of obviousness of the subject matter claimed.

The Office concedes on page 2 of the Final Office Action that Sadow does not disclose a handle being pivotable relative to the distal end of the arm portion. The Office and the Appellants agree on this point.

Liang is cited in the Office Action as disclosing an arm portion with an adjustable length and a handgrip that can pivot about the distal end of the arm, and the Office Action asserts that it would be an obvious alternative to use the Liang handle in the bag of Sadow.

Sparks is cited for teaching a separate connector for a handle, and the Office Action

asserts that it would have been obvious to provide a separate connector for mounting the end of the handle to enable one to install the handle properly.

Appellants respectfully traverse the positions taken with respect to Sadow, Liang and Sparks for numerous reasons.

The proffered motivation to use the sparks connector to enable one to install a handle properly is not consistent with the disclosures of the references themselves, nor is it supported by any objective evidence on the record. Nothing in the disclosures of Sadow and Liang indicate any problems with installation of their respective handles that would have logically commended one in the art at the time of the invention to utilize the Sparks connector with the Liang handle. Further, even if the combination cited in the Office Action were to be pursued, it would not result in the invention claimed.

The combination of Sadow and Liang is questionable vis-à-vis the presently claimed invention, and the combination presents a number of issues that Sparks is of no aid in resolving. Appellants submit that Sadow and Liang references teach away from one another on material points of the invention as claimed. Due to such differences and inconsistencies in the teaching of the Sadow and Liang references, which Sparks does not cure, it is respectfully submitted that a *prima facie* case of obviousness has not been established. As the U.S. Supreme Court recently noted, obviousness cannot be established merely by demonstrating that claim elements were individually known in isolation, and the proffered motivation to combine set forth in the Final Rejection is believed to be inadequate to provide a rational underpinning to support the conclusion of obviousness.

The Liang article of luggage includes, as shown in the figures, front casters (24) that are described as freely and omnidirectionally pivotal, and orientationally fixed rear wheels (24) that follow the direction of travel of the suitcase as it is pulled by a user. Liang discloses a steering apparatus for the suitcase including a ball (32) and socket (30) joint, a pivotal hinge (38), telescoping rods (54) and (56), and a handle (42) that in combination allow easy and convenient steering of the suitcase in any direction. Also, Liang notes that the position of the socket (30) is below the center of gravity of the case (10) for enhanced stability of the case while being steered and reducing a likelihood that the case will tip or fall over. The Liang handle is therefore

submitted to address particular issues and concerns that neither the devices of Sadow nor Sparks present.

The Sadow disclosure addresses the problem of towing a bag along a passenger isle of an aireraft, and accordingly includes a first set of wheels (14) on the major dimension of the base, and a second set of wheels (16) on the minor dimensions of the base. In use, the user extends the handle (20) and angles or tips the case for its weight to be positioned over one of the sets of wheels (14) and (16). See Sadow col. 3, lines 16-18 and Figure 2. Thus, the Sadow case requires tipping of the bag that Liang is aimed to prevent. Additionally, the free rotation of the Liang handle would not be desirable in the Sadow case because if the handle was allowed to be positioned obliquely with respect to the wheels (14) or (16) of the Sadow case, the case would tip and disengage the wheels from the ground, making the case very difficult to tow along a narrow passenger isle of an aircraft. The Sadow handle is purposefully designed with 90° pulling positions for towing the handle on one set of wheels or the other, and the Liang handle that is freely rotatable would be unworkable in the Sadow case.

With respect to the connector as recited in independent claim 30, the Liang handle includes, as shown in Figure 10 of Liang, a handle securing ridge (70) configured for rotatable mounting about a second retaining lip (72) on the end of the rod (56). That is, Liang discloses a handle (42) that mounts directly to the rod (56), and the handle (42), including the securing ridge (70), rotates as a single piece upon the rod (56). The Liang handle would obviate any need for a separate connector, including but not limited to the Sparks connector. Nothing in the written description of Liang describes or suggests that a connector would be necessary or desirable to properly mount the handle to the rod.

Sparks describes a ferrule attachment for uniting a handle and shank of a shovel. To that end, Sparks describes a simple practical and efficient means for "rigidly uniting" the ferrule to the handle. *See* Sparks page 1, lines 16-19. Sparks describes a ferrule (2) provided with a groove (7) that receives a bar (3). The bar (3) is joined to the ferrule (2) with a rivet (8) to "lock the bar and ferrule to each other against relative movement." *See* Sparks page 1, lines 62-67. Sparks further describe that the shank is snugly fitted within the ferrule to "prevent relative movement of the parts one upon the other." *See* Sparks page 1, lines 70-77. As such, the Sparks

ferrule (2) is provided to positively prevent any movement of the handle (4) relative to the ferrule (2), and also to prevent any movement of the ferrule (2) relative to the shank (1). From this perspective, Sparks, like Sadow, does not disclose a pivoting handle construction at all and adds nothing to the teaching of Liang with respect to the invention claimed. The Sparks ferrule (2), if used with the Liang handle and the Sadow case, would not result in the claimed invention, and would apparently render the Liang handle inoperative to move as Liang describes. The rigidly united handle assembly of Sparks simply does not logically commend itself to the Liang disclosure concerning a movable handle or to the invention presently being claimed.

None of Sadow, Liang, and Sparks, whether considered separately or in combination, disclose or suggest a separately provided connector, and a hand grip that can pivot relative to said connector about a pivot axis that intersects the hand grip, in combination with the other recitations of claim 30. There is no apparent reason why such a connector would be desirable or advantageous in view of the teaching of Sparks, Sadow or Liang. The motivation provided in the Office Action to provide such a connector, namely to enable one to install the handle properly, finds no support in the cited references. Liang and Sparks, for example, express opposing views on "proper" mounting of the handle in that Liang advocates a handle directly connected to a rod so that it may rotate as a single piece on the rod, while Sparks advocates an indirect connection to a shank via the ferrule which positively prevents any relative movement between any of the parts.

Claim 30 is accordingly submitted to be patentable over the cited art, and when the recitations of dependent claims 34, 35 and 38-47 are considered in combination with the recitations of claim 30, claims 34, 35 and 38-47 are likewise submitted to be patentable over the cited art.

Appellants accordingly request that the § 103(a) rejection of claims 30, 34, 35 and 38-47 be reversed.

(b.) Sadow in view of Liang, Sparks and Browning.

Appellants request that the rejection of claims 32 and 33 under 35 U.S.C. § 103(a) as being unpatentable over Sadow in view of Liang and Sparks and further in view of Browning be reversed.

Browning is cited for teaching an arm having a non-circular cross section. Browning does not cure the deficiencies of Sadow, Liang and Sparks with respect to claim 30 discussed above, and claim 30 is submitted to be patentable over the cited art. Browning does not teach a separately provided connector and a handle that can pivot relative to the connector, nor does it cure the incompatible teaching concerning certain aspects of the claimed invention that are detailed above with respect to the teaching of Sadow, Liang and Sparks.

Claim 30 is therefore submitted to be patentable over the cited art. Likewise. When dependent claims 32 and 33 when considered in combination with independent claim 30, claims 32 and 33 are likewise submitted to be patentable over the cited art.

(c.) Sadow in view of Liang, Sparks, and Miyoshi.

Appellants request that the rejection of claims 48, 49 and 50 under 35 U.S.C. § 103(a) as being unpatentable over Sadow in view of Liang and Sparks, and further in view of Miyoshi be reversed.

Miyoshi fails to disclose a pivoting handle at all, and like Sadow and Sparks fails to add anything to the teaching of Liang with respect to the invention claimed. The combination of references simply fail to disclose or suggest a connector that facilitates pivoting of a handle as recited in independent claim 48. Only Liang describes a handle that can move relative to another component, and Liang accomplishes such relative movement with a direct connection that does not involve a connector. Sparks is the only cited reference that discloses a connector, and it serves to positively prevent movement of the handle *relative to the connector* as claim 48 recites.

Additionally, Miyoshi does not cure the incompatible teaching of Liang and Sparks, and also does not cure incompatibilities in the teaching of Sadow, Liang and Sparks concerning certain aspects of the subject matter claimed.

Independent claim 48 is therefore submitted to be patentable over the cited art. Dependent claims 49 and 50, when considered in combination with claim 48, are likewise submitted to be patentable over the cited art.

Appellants accordingly request that the rejection of claims 48, 49 and 50 be reversed.

(d.) Williams et al.

Appellants respectfully submit that the rejection of claims 30, 34, 35, 37, and 42-47 as being anticipated by Williams et al. is predicated on an overbroad an inappropriate interpretation the Figures of the Williams et al. disclosure concerning aspects that Williams et al. either does not describe at all in the text of the disclosure, or that Williams et al. describes inconsistently with the interpretation of the Figure asserted by the Office in the Final Rejection. Appellants accordingly ask that the rejection be reversed.

As explained by the Federal Circuit, the requirements of Section 102, which is generally referred to as "anticipation", requires a disclosure in a single piece of prior art of each and every limitation of a claimed invention. Apple Computer, Inc. v. Articulate Systems, Inc., 57 USPQ2d 1057, 1061 (Fed. Cir. 2000). A finding of anticipation requires that the publication describe all of the elements of the claims arranged as in the patented device. C.R. Bard, Inc. v. M3 Systems, Inc., 48 USPQ2d 1225, 1320 (Fed. Cir. 1998). Under this analysis, the citation of Williams et al. as an anticipating reference of the subject matter presently claimed is problematic on a number of levels.

Appellants specifically point out that in all embodiments of the handle (20) disclosed by Williams et al., the handle includes a button snap (72) that engages a notched receptacle (70) to rigidly hold the handle (20) in place. See Williams et al. col. 4, lines 39-48 and Figure 6. As such, when the pole (50) is fully extended, the handle (20) is not pivotable because it is locked relative to the bag via the button snap (72) and the notched receptacle (70). The pivoting of the handle relative to the distal end of a retractable or telescoping arm, when the arm is in the extended position, as recited in independent claim 30 is therefore not disclosed by Williams et al.

Moreover, the locking of the handle (20) with the button snap (72) is important in the Williams et al. bag to support the bracket assembly (22) and the attached bag to allow the bag to be pushed as shown in Figure 8. Any pivoting of the Williams et al. handle when the pole is in the extended position would apparently defeat this support structure for the bag, and the Williams et al. disclosure is therefore not suggestive of independent claim 30.

Judging by the Figures of Williams et al., the pole (50) appears to be circular in cross section, allowing the pole (50) to rotate within the protective cover (7) so that the handle (20) can

be oriented in different positions relative to the baggage. In other words, it is likely that movement of the Williams et al. handle (20) by the applied force of the user causes the entire pole (50), or portions thereof, to twist or pivot together with the handle. From this perspective, the Williams et al. handle is believed to be similar to the Sadow handle, and is believed to be distinguishable from the presently claimed invention recited in independent claim 30 for similar reasons

Williams et al. clearly disclose that the telescoping pole (50) includes three portions (50a), (50b) and (50c). *See* Williams et al. col. 5, lines 27-31 and lines 61-62. At an earlier point in prosecution (*see, e.g.*, the Office Action dated October 11 2007), the Office considered portion (50a) to be the stem of the handle, which Appellants submitted to be improper as it is inconsistent on its face with the teaching of Williams et al. As Appellants argued, the tube portion (50a) is not properly considered to be a handle stem as the Office alleged because the portion (50a) is disclosed as being part of the pole (50) and not part of the handle (20). The alleged rotation of the pole portion (50a) with respect to the pole portion (50b), as the Office purported, likewise cannot properly be considered to be a handle rotating with respect to a distal end of the pole (50b). The distal end of the pole would be the end of the portion (50a), and not the portion (50b).

In the present and final rejection, the Office has changed its position and cites portion (50a) of Williams as corresponding to the connector recited in claim 30. Appellants note that portion (50a) is described as a tubular section of a pole (50) and as such cannot reasonably considered to be the recited connector. Additionally, the portion (50a) is clearly not fixedly mounted to the distal end of an arm portion as claim 30 recites, but rather is a telescoping tube section that has freedom of movement with respect to the other pole sections as illustrated in Figures 9 and 10. No element of Williams et al. meets the language of the recited connector, and it is not believed that Williams anticipates any reasonable reading of the present claims.

In the Final Rejection Appellants were advised that the Office can interpret the claims broadly during prosecution and the claims read on the Williams et al. disclosure.

In reply, Appellants respectfully submit that the Office is not reading the claims broadly in a manner that reads on the Williams et al. disclosure, but rather is interpreting the Williams et

al. figures broadly in a manner that corresponds to the claim language. The former would perhaps be permissible provided that the broad view of the claims language is consistent with its supporting written description. The latter, however, is not believed to be permissible under any circumstance. The Office is not free to disregard the written description of prior art references when evaluating what the prior art teaches or suggests to those in the art.

Appellants accept that in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification. In re Sneed, 218 USPQ 385 (Fed. Cir. 1983). The PTO is to apply to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification. In re Morris, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). This does not mean, however, that the Office can reasonably conclude that a claimed "handle" and a claimed "connector" can be interpreted broadly enough to read on a pole unless the associated specification reasonably supports such a view. In the present circumstance, the Appellants' specification clearly distinguishes the towing handle structure from the arm structure, and also distinguishes the connector structure from the arm and handle structure. Williams et al. also clearly distinguishes handle components from pole components. There is no tenable position that the "towing handle" described and claimed could reasonably be construed as referencing the arm portion described by Appellants, or the arm portion/pole described in another patent reference such as Williams et al., but this is in effect what the Office is doing in the instant rejection.

Appellants acknowledge that identical terminology is not required for an anticipation rejection to be found. *See* MPEP § 2131. Indeed, Appellants refer to telescoping arm portions while Williams et al. refer to telescoping pole sections, each of which refer to corresponding features using different terminology. Appellants are aware of no authority, however, that would authorize the Office to ignore, or even reject, pertinent terminology and the context in which it used in a prior art reference. Thus, when Williams et al. identifies an element as a pole, the Office is not free to disagree and consider the pole to be a handle. Such a rejection fails to reasonably apply the ordinary usage of the words as they would be understood by one of

ordinary skill in the art.

The Federal Circuit has held that:

> In determining whether such a suggestion [of obviousness] can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention. . . . *Evidence that supports, rather than negates, patentability must be fairly considered.*

In re Dow Chemical Co., (5USPQ2d 1529 at 1531-1532 (Fed. Cir. 1988) (emphasis added). The Office appears to be rejecting what Williams et al. actually teaches, which undermines the conclusion of obviousness, in favor of a broader view that supports it. The Office may not modify and supersede the actual teaching of Williams et al. under the guise of taking a broad view of the claim language.

The Office is not entitled to take broad views of the prior art such as the Office has done here, where the Office simply ignores the ordinary usage of the words used in the disclosure, and associated teaching of the Williams et al. reference. In other words, the Office appears to have deliberately failed to take into account whatever way of enlightenment by way of definition or otherwise that may be afforded by the written description of the prior art, and instead has opted to broadly interpret drawings in the Williams et al. reference separate and apart from its written description. As a result, the Office has concluded, for example, that components that the written description of Williams et al. discloses to be an element of a pole, are for purposes of examination considered to be a handle, and also that components described in the Williams et al. written description as a pole can for purposes of examination be considered to be a connector. Particularly egregious is that the Office has considered the pole section 50a disclosed by Williams et al. to correspond to different claimed features (e.g., the handle stem at one point and the connector at a another) at different times in prosecution, thus presenting a moving target to Appellants as they attempted to secure allowance of the claims. At the very least, the Office should adopt and maintain a single interpretation of the Figures relied upon in the Williams et al. reference.

MPEP § 2125 does permit drawings to be the basis for a prior art rejection, and drawings

can anticipate claims if they clearly show the structure which is claimed. MPEP § 2125 carefully states, however, that the drawings must be evaluated for what they reasonably disclose and suggest to those of ordinary skill in the art. One would be remiss to attempt to evaluate this issue without consulting the written description of the Williams et al. patent, which contrary to the views taken by the Office in the present rejection, clearly demarcates which of the components illustrated are handle components and which are not.

In all fairness, Appellants respectfully submit that the disclosure of Williams et al. is completely silent regarding *how* the handle (20) is attached to the pole, and does not specifically describe *how* the handle is moved between the positions shown in Figures 5 and 8 for use. Appellants also note that Williams et al. disclose an inner tube (51) within the pole portion (50a), but Williams et al. are likewise conspicuously silent regarding *how* the handle (20) attaches to the inner tube (51) and what role, if any, it might play in accomplishing the movement of the handle between the positions shown in Figures 5 and 8. In any event, Williams et al. simply do not disclose that the handle (20) can pivot *relative to* a distal end of the telescoping pole (50).

As Appellants have explained in detail, the interpretation of the Williams et al. cross section that underlies the present rejection should not be sustained for at least two reasons. First, it is inconsistent with explicit teaching of the Williams et al. references regarding which components are considered to be handle components or pole components. Second, the interpretation is speculative unless supported by some objective evidence, which the written description of Williams et al. does not supply. The written description is simply silent on material aspects of the subject matter being claimed, and the Williams et al. cross section in the figures is at best ambiguous regarding the features that the Office attempts to rely upon. As a whole, Appellants submit that the Williams et al. text and figures fails to present a *prima facie* case of unpatentability of the claimed invention.

For at least the reasons discussed above, Williams et al. is not an anticipating reference for independent claim 30. Likewise, Williams is not believed to suggest the invention of claim 30.

Dependent claims 34, 35 and 42-47 depend directly or indirectly from claim 30, and when the recitations of claims 34, 35 and 42-47 are considered in combination with the

recitations of claim 30, claims 34, 35, and 42-47 are likewise submitted to be patentable over Williams et al.

Appellants accordingly request that the § 102 rejection of claims 30, 34, 35, 37, and 42-47 over Williams et al. be reversed.

VIII. Claims Appendix

An appendix containing the rejected claims is attached as Appendix A.

IX. Evidence Appendix

The declaration submitted under Rule 1.132 referred to above is attached as Appendix B.

X. Related Proceeding Appendix

While related proceedings have been identified above in Part II, as of the date of submission of this brief no decision has been rendered in any of the related proceedings. Therefore, there is no corresponding appendix including such decisions.

XI. Conclusion

For the foregoing reasons, reversal of the Final Rejection of the claims is respectfully requested.

The fee set forth in 37 C.F.R. § 41.20 was previously paid.

Respectfully submitted,

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APPENDIX A

Claims Involved in the Appeal

1-29. (cancelled)

30. (previously presented) A hand towed piece of baggage comprising:

a piece of baggage having a top and a bottom;

a set of wheels rotationally mounted towards said bottom of said piece of baggage;

a receptacle providing an opening in said top of said piece of baggage;

an arm portion retractably engaged to said piece of baggage and having an adjustable axial length extending between opposite proximal and distal ends, said proximal end being operatively secured to said piece of baggage and said distal end positionable between an extended position and a retracted position through said receptacle, wherein in said retracted position said distal end is closer to said piece of baggage than in said extended position;

a connector fixedly mounted to said distal end; and

a towing handle having a hand grip, the towing handle being separately provided from the connector and engaged to the connector such that said hand grip can pivot relative to said connector about a pivot axis that intersects the hand grip when said arm portion is in said extended position, and such that said towing handle grip is retracted at least partially into said receptacle when said arm portion is in said retracted position.

31. (previously presented) The piece of baggage of claim 30, wherein:

said arm portion has a center axis along the axial length, the center axis defining an arcuate telescoping path for moving the distal end between the extended and retracted positions.

32. (previously presented) The piece of baggage of claim 30, wherein:

said arm portion has a non-circular cross-section perpendicular to the axial length.

33. (previously presented) The piece of baggage of claim 32, wherein:

said arm portion is arcuate along the axial length.

34. (previously presented) The piece of baggage of claim 30, wherein:

said arm portion is a single-pole arm portion.

35. (previously presented) The piece of baggage of claim 34, wherein:

said single-pole arm portion is arcuate between the proximal and distal ends along a center axis corresponding to said axial length.

36. (cancelled)

37. (cancelled)

38. (previously presented) The piece of baggage of claim 30, wherein:

the pivot axis bisects the hand grip of the towing handle.

39. (previously presented) The piece of baggage of claim 38 wherein:

said towing handle further comprises a stem connected to said handgrip.

40. (previously presented) The piece of baggage of claim 39, wherein:

said stem intersects said handgrip at a generally perpendicular relation.

41. (previously presented) The piece of baggage of claim 39, wherein:

said stem extends from one end of said handgrip and curves to said distal end of said arm portion.

42. (previously presented) The piece of baggage of claim 39, wherein:

said stem comprises a single stem.

43. (previously presented) The piece of baggage of claim 30 wherein:

said towing handle further comprises a stem connected to said handgrip.

44. (previously presented) The piece of baggage of claim 43, wherein:

said stem intersects said handgrip at a generally perpendicular relation.

45. (previously presented) The piece of baggage of claim 43, wherein:

said stem extends from one end of said handgrip and curves to said distal end of said arm

portion.

46. (previously presented) The piece of baggage of claim 43, wherein:

said stem comprises a single stem.

47. (previously presented) The piece of baggage of claim 30, wherein:

in said retracted position, said towing handle lies flush with said piece of baggage.

48. (previously presented) A hand towed piece of baggage comprising:

a piece of baggage;

a set of wheels rotationally mounted on the piece of baggage;

a retractable arm portion, the arm portion comprising a plurality of tubular sections that are telescopically engaged with each other and having an axial length extending between opposite proximal and distal ends, the proximal end being operatively secured to the piece of baggage and the distal end being selectively movable between a retracted position and an extended position relative to the proximal end via the tubular sections telescoping in a manner such that the distal end is closer to the piece of baggage when in the retracted position than when the distal end is in the extended position, the arm portion further having a non-circular cross section perpendicular to the axial length so that the tubular sections cannot slidably twist relative to each other when the distal end of the arm portion is in the extended position;

a connector mounted stationary to the distal end;

a towing handle having a hand grip, the towing handle being separately provided from the connector and abutting the connector in a manner such that the hand grip can pivot relative to the connector about a pivot axis that intersects the hand grip when the distal end of the arm portion is in the extended position;

wherein the towing handle is generally unobtrusive when in the retracted position.

49. (previously presented) The piece of baggage of claim 48, wherein:

the tubular sections of the arm portion are arcuate along their axial lengths.

50. (previously presented) The piece of baggage of claim 48, wherein:

the arm portion is a single-pole arm portion.

51. (cancelled)

52. (cancelled)

53. (previously presented) A hand towed piece of baggage comprising:

a piece of baggage;

a set of wheels rotationally mounted on the piece of baggage;

a retractable arm portion, the arm portion comprising a plurality of curved tubular sections that are telescopically engaged with each other and having an arched axial length extending between opposite proximal and distal ends, the proximal end being operatively secured to the piece of baggage and the distal end being selectively movable between a retracted position and an extended position relative to the proximal end via the tubular sections telescoping in a manner such that the distal end is closer to the piece of baggage when in the retracted position than when the distal end is in the extended position;

a connector mounted stationary to the distal end;

a towing handle having a hand grip, the towing handle being separately provided from the connector and abutting the connector in a manner such that the hand grip can pivot relative to the connector about a pivot axis that intersects the hand grip when the distal end of the arm portion is in the extended position.

54. (previously presented) The piece of baggage of claim 53, wherein the arm portion further has a non-circular cross section perpendicular to the axial length so that the tubular sections cannot slidably twist relative to each other when the distal end of the arm portion is in the extended position.

55. (previously presented) The piece of baggage of claim 53, the towing handle comprising a stem that is integrally formed with the handle grip, the stem defining a bearing surface for abutment with the connector.

56. (previously presented) The piece of baggage of claim 53, wherein the telescoping of the tubular sections follows an arcuate path extending away from a center axis of the piece of baggage.